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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/904,182	07/11/2001	Albert C. Lardo	56245	1162

7590 10/15/2002

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EXAMINER

SHAY, DAVID M

ART UNIT

PAPER NUMBER

3739

DATE MAILED: 10/15/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

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This is a communication from the examiner in charge of your application.
 COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on February 11, 2002

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-54 is/are pending in the application.
 Of the above, claim(s) _____ is/are withdrawn from consideration.
☐ Claim(s) _____ is/are allowed.
☒ Claim(s) 1-4, 6-17, 20-25, 27-29 + 51-54 is/are rejected.
☒ Claim(s) 5, 13, 19, 26, + 30-50 is/are objected to.
☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
☐ The specification is objected to by the Examiner.
☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.
☐ received in Application No. (Series Code/Serial Number) _____
☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☒ Notice of Reference Cited, PTO-892
☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4
☐ Interview Summary, PTO-413
☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
☐ Notice of Informal Patent Application, PTO-152

-SEE OFFICE ACTION ON THE FOLLOWING PAGES-

1. Claims 5, 18, 19, 26, and 30-50 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only and cannot depend from any other multiple dependant claim. See MPEP § 608.01(n). Accordingly, these claims have not been further treated on the merits.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-4, 6, 8-11, 13-17, 20-25, 27-29, and 51-54 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claims 1-4 recite a device but have no positive recitation of structure. In claim 6 "the high resolution MRI receiver" and "the fiber optic laser" lack positive antecedent basis. In claim 8 "the coil" and "the treatment area" both lack positive antecedent basis. In claim 9 "the illumination"; "the tip"; and "the fiberoptic laser" all lack positive antecedent basis. In claims 9-11 and 13-15 there is no positive recitation of structure. Claim 11 is further unclear because the term "any one or" is unclear. For the purpose of examination, the term, will be read as -- any one of --. In claim 12 exactly what constitutes "high resolution imaging" is unclear. Claims 16 and 17 recite no structure other than a device. Claim 20, 22, 23, 25 and 51-54 recite no method steps. Claims 21 and 24 lack any transitional phrase (e.g. "comprising", "consisting of") -- "comprising" will be assumed. It is also noted that the claims are replete with functional language which is not of the proper form to be considered structurally limiting. See MPEP 2181.

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1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

5. Claims 1-3, 7-17, 20, 21, 24, 25, and 52-54 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Motamedi et al.

See column 5, line 55 to column 6, line 17, and Figures 1, 3 and 4.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 22, 23 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swanson in combination with Motamedi et al. Swanson teaches that one of the ectopic foci involved in arrhythmias is the pulmonary vein. Motamedi et al teach that both PDT and various forms of ablation can be used to control arrhythmias. It would have been obvious to the artisan of ordinary skill to monitor endpoints as claimed so as to avoid over treatment and to employ PDT to ablate the tissue of the pulmonary vein causing the arrhythmia in the method of Swanson, since these are equivalents in the art, as taught by Motamedi et al, or alternatively to ablate the tissue of the pulmonary vein causing the arrhythmia in the method of Motamedi et al, since this is a known area

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that can be involved in arrhythmias, as taught by Swanson, thus producing a method such as claimed.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Shay whose telephone number is (703) 308-2215. The examiner can normally be reached Tuesday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached at (703) 308-0994.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

David Shay:bhw
October 11, 2002

October 10, 2002



DAVID M. SHAY
PRIMARY EXAMINER
GROUP 330